

REMARKS

This amendment is submitted in response to the Non-Final Office Action mailed February 27, 2007 ("Office Action"). Claims 14-17 and 20-22 are pending. Claim 14 is independent. In the Office Action, the Examiner:

- rejected claims 14-15, 17, and 20-22 under 35 U.S.C. § 102(b) ("Section 102(b)") as anticipated by U.S. Pat. No. 4,417,576 to Baran ("Baran"); and
- rejected claim 16 under Section 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) ("Section 103(a)") as obvious over Baran.

Rejections Under Section 102(b)

Claims 14-15, 17, and 20-22 are rejected under Section 102(b) as anticipated by Baran. This rejection is respectfully traversed.

Independent claim 14 recites "a balloon," "a membrane," and "a reservoir disposed between the outer surface of the balloon[] and the inner surface of the membrane . . .[,] wherein the reservoir is connected to a reservoir lumen for filling the reservoir with biologically active material." Applicants respectfully submit that Baran does not disclose, teach, or suggest a reservoir. Assuming only for the sake of argument that the Examiner correctly identified reference letter U of Baran to be a membrane and reference letter E to be a balloon, Applicant respectfully disagrees that "the space between 'membrane' U and the balloon E" serves as a reservoir. (Office Action at 4.) Baran does not disclose, teach, or suggest a space between sponge-like material U and internal cuff E. Instead, Baran teaches that the space between internal cuff E and external cuff D is filled with sponge-like material U. (Col. 3, lines 1-3.) There is no space between internal cuff E and sponge-like material U. Further, rather than filling a reservoir (which the device of Baran does not have) with biologically active material, Baran discloses that "anesthetic fluid H is injected into sponge-like material U under enough pressure to saturate material U." (Col. 3, lines 16-18.) Thus, the anesthetic fluid is injected into what the Examiner has labeled as "'membrane' U," (Office action at 4), not into a reservoir.

Additionally, independent claim 14 discloses a "sponge coating . . . exposed to the body lumen . . . [and] having a plurality of voids[,] . . . wherein biologically active material can . . . enter the voids." Baran does not disclose, teach, or suggest a sponge coating exposed to the body lumen. Instead, the outer surface of the device of Baran is external cuff D.

External cuff D cannot be a sponge coating, because it must be rigid enough so that distending internal cuff E will compress sponge-like material U against external cuff D such that there is a uniform coat of anesthetic H about external cuff D. (Col. 2, lines 23-27; col. 3, lines 16-27.) Also, external cuff D cannot be a sponge coating, because it then would be part of sponge-like material U, whereas Baran discloses both sponge-like material U and external cuff D. For these reasons, contrary to the Examiner's position, external cuff D is not a sponge coating.

Thus, Baran does not disclose, teach, or suggest each and every element of independent claim 14. Therefore, Applicants respectfully submit that the rejection of claim 14 should be withdrawn. Because dependent claims 15, 17, and 20-22 depend from independent claim 14, the rejection of claims 15, 17, and 20-22 should be withdrawn for at least the same reasons that the rejection of claim 14 should be withdrawn.

Rejections Under Section 103(a)

Claim 16 is rejected under Section 102(b) as anticipated by, or in the alternative, under Section 103(a) as obvious over Baran. This rejection is respectfully traversed.

As discussed above, Baran does not disclose each and every element of independent claim 14; in particular, Baran fails to disclose, teach, or suggest a "reservoir" or a "sponge coating." There is no teaching, suggestion, or motivation to modify Baran to contain a reservoir or a sponge coating. With respect to the reservoir, it would not be obvious to modify the device of Baran to put a reservoir between sponge-like material U (the element the Examiner calls the membrane) and internal cuff E (the element the examiner calls the balloon). Sponge-like material U would absorb any anesthetic added to the reservoir, and therefore the reservoir would serve no purpose. With respect to the sponge coating, it would not be obvious to put a sponge coating on the outside of the device of Baran. There is no teaching, suggestion, or motivation to have a sponge coating outside external cuff D, and it would not be obvious to modify external cuff D to be a sponge coating, because that would effectively remove external cuff D and make external cuff D part of sponge-like material U. Baran teaches having both sponge-like material U and external cuff D, where the sponge-like material U is compressed against external cuff D in order to force the anesthesia through external cuff D to the target. (Col. 2, lines 23-27; col. 3, lines 16-27.) If external cuff D is removed, the device of Baran would not operate as intended.

Thus, independent claim 14 is not obvious to one of ordinary skill in the art over Baran. Because claim 16 depends from independent claim 14, the rejection of claim 16

should be withdrawn for at least the same reasons that Baran does not render claim 14 obvious.

Claim 16 recites that “the void space of the sponge coating is greater than about 60% of the volume of the sponge coating.” Because Baran does not disclose, teach, or suggest a sponge coating and it would not be obvious to modify Baran to have a sponge coating, the recited percentage of void space is also not disclosed or suggested by Baran. Additionally, and only for the sake of argument, even if external cuff D were a sponge coating and the perforations at M were voids, Baran still discloses no percentage of perforation space relative to volume of external cuff. Therefore, the rejection of claim 16 should be withdrawn for this additional reason.

CONCLUSION

It is believed that claims 14-17 and 20-22 are in condition for allowance. Should the Examiner not agree with any of Applicants' positions or arguments herein, a telephonic or personal interview is respectfully requested to discuss and resolve any remaining issues.

No fee is believed due for this response. Should any fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Acct. No. 50-3013.

Date: May 21, 2007

Respectfully submitted,



58,442

Kenneth S. Canfield

(Reg. No.)

For: Gidon D. Stern

(Reg. No. 27,469)

JONES DAY

222 East 41st Street

New York, New York 10017

(212) 326-3939